

ADMINISTRATIVE PANEL DECISION

Bayerische Motoren Werke AG (BMW) v. Jennifer Scifo, Codersfx.com
Case No. D2023-4309

1. The Parties

The Complainant is Bayerische Motoren Werke AG (BMW), Germany, represented by Kelly IP, LLP, United States of America ("United States").

The Respondent is Jennifer Scifo, Codersfx.com, United States.

2. The Domain Name and Registrar

The disputed domain name <bmwtechusa.com> is registered with GoDaddy.com, LLC (the "Registrar").

3. Procedural History

The Complaint was filed with the WIPO Arbitration and Mediation Center (the "Center") on October 17, 2023. On October 18, 2023, the Center transmitted by email to the Registrar a request for registrar verification in connection with the disputed domain name. On October 18, 2023, the Registrar transmitted by email to the Center its verification response disclosing registrant and contact information for the disputed domain name which differed from the named Respondent (Registration Private, Domains By Proxy, LLC) and contact information in the Complaint. The Center sent an email communication to the Complainant on October 19, 2023, providing the registrant and contact information disclosed by the Registrar, and inviting the Complainant to submit an amendment to the Complaint. The Complainant filed an amended Complaint on October 20, 2023.

The Center verified that the Complaint together with the amended Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the "Policy" or "UDRP"), the Rules for Uniform Domain Name Dispute Resolution Policy (the "Rules"), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the "Supplemental Rules").

In accordance with the Rules, paragraphs 2 and 4, the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 23, 2023. In accordance with the Rules, paragraph 5, the due date for Response was November 12, 2023. The Respondent did not submit any response. Accordingly, the Center notified the Respondent's default on November 13, 2023. The Respondent sent an email communication to the Center on November 13, 2023.

The Center appointed Ganna Prokhorova as the sole panelist in this matter on November 28, 2023. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7.

4. Factual Background

Founded in 1916, the Complainant is a worldwide known manufacturer of automobiles and motorcycles.

The Complainant is the owner of numerous trademarks consisting of or comprising the letters “bmw”. These registrations are worldwide, including in the country where the Respondent is located, in particular:

- German Trademark Registration No. 410579 for the mark BMW, registered on November 15, 1929, in respect of goods under international classes 7 and 12;
- United States Trademark Registration No. 611710 for the mark BMW, registered on September 6, 1955, in respect of goods under international class 12; and
- United States Trademark Registration No. 1164922 for the mark BMW registered on August 11, 1981, in respect of services under international classes 37 and 42.

The Complainant also owns many BMW-incorporating domain names, with its primary websites being located at <bmw.com> and <bmwgroup.com>. The Complainant also holds country-specific and region-specific websites located at BMW-formative domain names, such as, for example, <bmwusa.com>, <bmw.ca>, and <bmw.de>.

The disputed domain name was registered on April 1, 2021, and at the moment of filing the Complaint resolved to a website that purported to provide online retail store services for the Complainant’s BMW brand diagnostic, software, and programming products, in addition to third-party brands.

The Respondent did not formally respond to the Complainant’s contentions, but just sent an informal reply saying:

“...we would like to express after speaking with GoDaddys legal dept they have informed us we didn’t infringe on BMW nor any of the WIPO rules. Their is hundreds of companies that own and repair BMW vehicles and use the BMW letters in their business name. We offered to sell BMW the domain and will fight this issue to the end. We can’t be forced to turn over a domain name because some big corporation wants to extort or bully us. The Domain are not owned by BMW, it’s owned by us. We will accept fair value price or we’ll hire an attorney and file suit against the WIPO and BMW”.

On the moment of considering this case the disputed domain name does not resolve to an active webpage.

5. Parties’ Contentions

A. Complainant

The Complainant contends that it has satisfied each of the elements required under the Policy for a transfer of the disputed domain name.

Notably, the Complainant contends that:

- 1) The disputed domain name is confusingly similar to the Complainant's BMW trademark as it prominently features it merely adding the term "tech," which relates to the Complainant's business, the geographic descriptor "USA", which refers to the United States and relates to the Complainant's business, and the generic Top-Level Domain ("gTLD") ".com", which is insufficient to distinguish the disputed domain name from the trademarks.
- 2) The Respondent has no rights or legitimate interests in the disputed domain name as the Respondent is not commonly known by the disputed domain name. In addition, the Complainant has not authorized the Respondent, or any associated person or entity, to use or register the trademarks in any manner, nor is the Respondent or any other associated person or entity a current or former licensee of the Complainant and the trademarks. Furthermore, the disputed domain name resolves to a website that purports to offer online retail store services for the Complainant's BMW brand diagnostic, software, and programming products, in addition to third-party brands. The Respondent uses the disputed domain name to prominently display and reproduce, without authorization, the Complainant's BMW trademarks. Such use of the disputed domain name and the trademarks does not amount to a *bona fide* offering of goods or services nor a legitimate noncommercial or fair use.
- 3) The Respondent had actual knowledge of the Complainant and the trademarks prior to registering and using the disputed domain name. The Complainant has continuously and exclusively used the trademarks around the world since at least 1917. Considering that the disputed domain name contains the BMW trademark and was registered by the Respondent many years after the Complainant's first use thereof it is inconceivable that the Respondent did not have actual knowledge of the Complainant and the trademarks when registering the disputed domain name. This is further established given that the disputed domain name resolves to a website that displays and reproduces the Complainant's BMW trademarks, and is purporting to provide online retail store services for the Complainant's BMW brand products as well as third-party brands. The Respondent's use of the confusingly similar disputed domain name in this manner in an attempt to pass itself off as the Complainant, or as affiliated with the Complainant, indicates the Respondent's bad faith registration and use of the disputed domain name. The Respondent has intentionally attempted to attract, for commercial gain, Internet users to the website located at the disputed domain name, by creating a likelihood of confusion with the trademarks as to the source, sponsorship, affiliation, or endorsement of the disputed domain name, the associated website, and/or the Respondent's activities.

B. Respondent

Apart the informal email communication, the Respondent did not formally reply to the Complainant's contentions.

6. Discussion and Findings

To succeed, the Complainant must demonstrate that all the elements listed in paragraph 4(a) of the Policy have been satisfied, as following:

- (i) the disputed domain name is identical or confusingly similar to a trademark or service mark in which the Complainant has rights; and
- (ii) the Respondent has no rights or legitimate interests in respect of the disputed domain name; and
- (iii) the disputed domain name has been registered and is being used in bad faith.

The Panel will further analyze the potential concurrence of the above circumstances.

Moreover, the Panel has taken note of the WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition ("[WIPO Overview 3.0](#)") and, where appropriate, will decide consistent with the consensus views captured therein.

A. Identical or Confusingly Similar

It is well accepted that the first element functions primarily as a standing requirement. The standing (or threshold) test for confusing similarity involves a reasoned but relatively straightforward comparison between the Complainant's trademark and the disputed domain name. WIPO Overview of WIPO Panel Views on Selected UDRP Questions, Third Edition, ("[WIPO Overview 3.0](#)"), section 1.7.

Based on the available record, the Panel finds the Complainant has shown rights in respect of a trademark or service mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.2.1.

The Panel finds the entirety of the mark is reproduced within the disputed domain name. Accordingly, the disputed domain name is confusingly similar to the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.7.

Although the addition of other terms here, "tech" and "usa" may bear on assessment of the second and third elements, the Panel finds the addition of such terms does not prevent a finding of confusing similarity between the disputed domain name and the mark for the purposes of the Policy. [WIPO Overview 3.0](#), section 1.8.

It is well accepted by UDRP panels that a gTLD, such as ".com", is typically ignored when assessing whether a domain name is identical or confusingly similar to a trademark. [WIPO Overview 3.0](#), section 1.11.1.

Based on the available record, the Panel finds the first element of the Policy has been established.

B. Rights or Legitimate Interests

Paragraph 4(c) of the Policy provides a list of circumstances in which the Respondent may demonstrate rights or legitimate interests in a disputed domain name.

Although the overall burden of proof in UDRP proceedings is on the complainant, panels have recognized that proving a respondent lacks rights or legitimate interests in a domain name may result in the difficult task of "proving a negative", requiring information that is often primarily within the knowledge or control of the respondent. As such, where a complainant makes out a *prima facie* case that the respondent lacks rights or legitimate interests, the burden of production on this element shifts to the respondent to come forward with relevant evidence demonstrating rights or legitimate interests in the domain name (although the burden of proof always remains on the complainant). If the respondent fails to come forward with such relevant evidence, the complainant is deemed to have satisfied the second element. [WIPO Overview 3.0](#), section 2.1.

Having reviewed the available record, the Panel finds the Complainant has established a *prima facie* case that the Respondent lacks rights or legitimate interests in the disputed domain name. The Respondent has not rebutted the Complainant's *prima facie* showing and has not come forward with any relevant evidence demonstrating rights or legitimate interests in the disputed domain name such as those enumerated in the Policy or otherwise.

On the basis of the evidence and arguments submitted, the Panel finds that the Respondent is not affiliated with the Complainant in any way. The Respondent has not been authorized by the Complainant to register or use the disputed domain name or to seek the registration of any domain name incorporating the BMW mark or a mark similar to the BMW mark.

The Panel notes that the Respondent is not commonly known by the disputed domain name, whereas the Complainant has prior rights in the trademarks, which precede the Respondent's registration of the disputed domain name.

There is no evidence that the Respondent has used or made demonstrable preparations to use the disputed domain name in connection with a legitimate noncommercial or fair use.

According to the consensus view in UDRP panel decisions ([WIPO Overview 3.0](#), section 2.8), a reseller or distributor can make a *bona fide* offering of goods and services and thus have a legitimate interest in the domain name if its use meets certain requirements. These requirements normally include the actual offering of goods and services at issue, the use of the site to sell only the trademarked goods or services, and the site's accurate and prominent disclosure of the registrant's relationship with the trademark holder. The respondent must also not try to "corner the market" in domain names that reflect the trademark. Many panels subscribing to this view have also found that not only authorized but also unauthorized resellers may fall within such so-called *Oki Data* principles (e.g., *Dr. Ing. h.c. F. Porsche AG v. Del Fabbro Laurent*, WIPO Case No. [D2004-0481](#)).

Having carefully inspected the website under the disputed domain name, the Panel found no clear disclaimer on the corresponding website that it is not the trademark owner, even if it offers legitimate goods, by accurately disclosing the Respondent's relationship with the trademark owner. Since the Respondent's website does not include any statement clearly setting out the relationship between the Complainant and the Respondent, the *Oki Data* criteria is not met here.

Furthermore, the website under the disputed domain name displays and reproduces the Complainant's BMW trademark, including in the website's banner, and purports to offer online retail store services for the Complainant's BMW brand diagnostic, software, and programming products, in addition to third-party brands. Prior UDRP Panels have consistently found no *bona fide* offering of goods or services as well as no legitimate noncommercial or fair use of a disputed domain name when it resolved to a website providing competing repair services for the Complainant as well as third-party brands. See *Bayerische Motoren Werke AG v. L&M Foreign Cars*, WIPO Case No. [D2018-1777](#); and *Bayerische Motoren Werke AG v. Gasparlin*, WIPO Case No. [D2017-0643](#).

Based on the available record, the Panel finds the second element of the Policy has been established.

C. Registered and Used in Bad Faith

The Panel notes that, for the purposes of paragraph 4(a)(iii) of the Policy, paragraph 4(b) of the Policy establishes circumstances, in particular, but without limitation, that, if found by the Panel to be present, shall be evidence of the registration and use of a domain name in bad faith.

In the present case, the Panel notes that the Respondent had actual knowledge of the Complainant and its BMW trademarks prior to registering and using the disputed domain name. The Respondent's actual knowledge of the Complainant is further established given that the disputed domain name resolves to a website that purports to provide online retail store services for the Complainant's BMW brand products and third-party brands, and in doing so, hosts content referencing and infringing the Complainant's BMW trademarks.

The Panel repeats its findings in respect of rights or legitimate interests above. In light of the fact that the disputed domain name wholly incorporates the Complainant's BMW trademark, the contents of the Respondent's website using the Complainant's marks heavily throughout the page that seems geared to giving the false impression that the Respondent is authorized by or affiliated with the Complainant, and its failure to include an accurate and prominent disclaimer on the website, the Panel concludes on balance that the Respondent both registered and is using the disputed domain name with the intention of taking unfair advantage of the Complainant's goodwill in its BMW trademark. Specifically, the Panel finds that, by using

the disputed domain name, the Respondent has intentionally attempted to attract, for commercial gain, Internet users to its website by creating a likelihood of confusion with the Complainant's mark as to the source, sponsorship, affiliation, or endorsement of its website or of goods on that website (paragraph 4(b)(iv) of the Policy).

Based on the available record, the Panel finds that the Complainant has established the third element of the Policy.

7. Decision

For the foregoing reasons, in accordance with paragraphs 4(i) of the Policy and 15 of the Rules, the Panel orders that the disputed domain name <bmwtechusa.com> be transferred to the Complainant.

/Ganna Prokhorova/

Ganna Prokhorova

Sole Panelist

Date: December 7, 2023